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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,481	04/04/2002	Kazuhiro Takagi	AM100246-00	1417

7590

09/02/2003

Basf Corporation  
Patent Department  
3000 Continental Drive North  
Mount Olive, NJ 07828-1234

EXAMINER
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LEVY, NEIL S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 09/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 7/10/03
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-5, 8-12 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-5, 8-12 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-5, 8-12 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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Receipt is acknowledged of Change of address and amendment.

Applicant's election with traverse of Group I, species of example 44 in Paper No. 9 is acknowledged. The traversal is on the ground(s) that applicant has now invention to methods, of combating many more species than the original art controlling compositions. As ants are the first species presented, they will be examined, with other species, not claimed, but disclosed (p.23, 24) assumed to be equivalent for purposes of examination. This is not found persuasive because the various forms of (1) have not been shown to be orthoptera, Psocoptera and Hymenoptera controllers; the restriction thus maintained, as otherwise burden some to examine non-elected variants of formula (1) against multiplicity of pest species to apply to soil pest or wood; also seen as equivalent targets. If applicant does not see pest species as equivalent, and the target species as equivalent, applicant should then elect the specific form of the now more broadly claimed pests and targets.

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5, 8-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

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which it pertains, or with which it is most nearly connected, to make and/or use the invention. The instant claims now require undesignated amounts applied to a vast array, inclusive of termites but extending to other orders of pests of to achieve an unspecified result, when applied to one pest, soil or wood. Applicant states that all compounds kill at an undesignated "markedly high" effect at "low-doses" all termites doing damage, gives-examples – but it is not clear if these are examples of tested termites or just those that do damage. The same is true of ants. Formulation are stated to be those that are proper, and adjusted if necessary; but condition when "proper" and "necessary" are not disclosed. Further the invention is specified as being applied to Furniture, wood articles, but no description as to how to apply, concomitantly with the stated application to soil, (p. 25) is disclosed.

Only 1 termite, a strain of *Coptotermes* was tested, and only in 500 ppm of an undesignated solvent, with no solvent control. Only those compounds producing 50% or more kill are reported - thus, we don't know if the other compounds had any effects on the test pest, to say nothing of others. Furthermore, only 2 compounds had a high effect on fire ants, the only other species tested of the array of compounds steeled to be ant controllers. The claims are beyond the scope of the specification, which supports. Fire ants directly treated with # 44 and 96, and *coptotermes Formosan* us treated with a number of compounds, 1-3, 9, 11, 12, 14, and 16 to achieve 100% mortality.

The factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. 112, first paragraph, have been described in *In re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988). Among these factor are: (1) the nature of the

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invention; (2) the state of the prior art; (3) the relative skill of those in the art; (4) the predictability or unpredictability of the art; (5) the breadth of the claims; (6) the amount of direction or guidance presented; (7) the presence or absence of working examples; and (8) the quantity of experimentation necessary. When the above factors are weighed, it is the examiner's position that instant disclosure fails to meet the enablement requirement for the following reasons;

(1) The nature of the invention: claims are to unqualified criteria and amount of a stated array of known compounds, also known as ant controllers, not further specified.

(2) The state of the prior art the use of these compounds for ant control is stated to be known, but not for any other species control.

(3) The relative skill of those in the art the relative skill of those in the art is high – at the Masters or entomologist level.

(4) The predictability or unpredictability of the art see YODER example 7 is – method of application is critical.

(5) The breadth of the claims they are beyond attainment, as shown by lack of effect of many of the compounds even in the termite test (cpds 5-8, 32-54, for example, and inclusive of the elected species, cpd. 441).

(6) The amount of direction or guidance presented extremely limited unspecific solvent in only death end point, was presented.

(7) The presence or absence of working examples limited there are no demonstrations of any of the criteria at the levels claimed.

(8) The quantity of experimentation necessary: extensive, with death required see Metcalf; for 3 of the orders, there were 124, 000 species known in '76.

Claims 1-5, 8, 10, 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

"Effective" is not identified as to what effective for; "combating" is not identified as what is intended attracting, repelling can be combating.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 8-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Takagi et al -5543573.

See example 14; the elected species suitable for controlling (the instant combatting) insect pests of agricultural, forest, horticultural and Sanitary habitats (col. 62, lines 6-117 and also effective as applied to the inside of houses and soil (ditches) around a house (col. 63, lines 7-18). Liquid and solid carriers and solvents are provided (col. 63, line 38 – Line 7, col. 64), to permit application to habitat or (col. 64, line 40 – 56) pest, at the instantly claimed rate. The methods per se as instantly claimed are

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clearly disclosed and as the habitats are those of the claimed insect termites of forest, field, and houses, they would be combated.

Claims 1-5, 8-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Toki et al – EP 0500111.

Compound 200 is an analog of the instant elected species of the claimed formula (11 of instant claims 1-5, as pesticidal to combat insects of the instant claims inclusive of ants (p.38, line 55), subterranean termites (p. 39, line 2) the, families instantly claimed included in this generic group, applied suspension or solid carries (p.39, lines 15-23) to soil at the instant rate (col. 43, lines 15-21).

Claims 1-5, 8-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Harrison et al WO 92/06076.

Here, too methods of application to soil or pests, including (p.54-57) ants, subterranean termites, the instant families, at the rates .1-150 mg/square meter, of the instant Hydrazine compounds (p.58) analogs of the elected compound; compound 4 is the formula, when Y=H.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is (703) 308-2412. The examiner can normally be reached on Tuesday through Friday 7 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Levy/LR  
August 20, 2003



NEIL S. LEVY  
PRIMARY EXAMINER